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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,624	08/07/2001	Satoru Matsuda	112857-283	2083
29175	7590	06/07/2005	EXAMINER	
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			HUYNH, BA	
			ART UNIT	PAPER NUMBER
			2179	

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/923,624

Applicant(s)

MATSUDA, SATORU

Examiner

Ba Huynh

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This communication is responsive to the amendment filed on 4/4/05. Claims 1-21 are pending in the application. Claims 1, 9, 10 and 11 were amended.

Typographical error detected by the applicant is noted and appreciated. Claims 1, 2, 5-7, 9-13, 18-20 were rejected under 35 U.S.C. 102(e) as being anticipated by US patent application publication 2003/0093474 (Kakuta et al) as have been correctly interpreted by the applicant.

#### ***Claim Rejections - 35 USC § 102***

1. Claims 1, 2, 5-7, 9-13, 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent application publication 2003/0093474 (Kakuta et al).

- As for claims 1, 9-12: Kakuta et al teach a computer implemented method and corresponding system for exchanging information, in virtual world (0008), between network terminals (fig. 9, 10), comprising the steps/means for:
  - first recording means for controlling the recording of information relating to a community composed of a plurality of users (0011),
  - second recording means for controlling the recording of information relating to the plurality of users (0010, 0012, 0069),
  - first generating means for generating a first set of information corresponding to a virtual space capable of being utilized the users of network terminals (0008, 0012, fig. 11, 16),

second generating means for generating a second set of information corresponding to an information list showing the community a first user participates in, from information relating to the plurality of users with its recording controlled by the second generating means (0067, fig. 16),

a display which displays a portion of the virtual space (i.e., the chat-room) and the information list (figs. 11, 13, 16),

first output control means for controlling the output of the first and second set of information to other network terminals (fig. 10),

input control means for controlling input from other terminals, of a fourth set of information showing the operation by the first user for giving a third set of

information (i.e., "group card") showing a specified community to a second user,

from among the second set of information generated by the second generation means,

within the virtual space generated by the first generation means, wherein the first

recording means controls the recording of information relating to the community

shown by the third set of information, on the basis of the fourth set of information

with input controlled by the input control means, and the second record control means

controls the recording of information relating to the first user and the second user, on

the basis of the fourth set of information with inputs controlled by the input control

means (0067-0070, 0099).

- As for claims 2, 13: A first user may authorize the acceptance of a second user into his community (0012, 0067).

- As for claim 5: Each user is provided with means for making conversation (0090), editing user information (0097), designating other as group member (0099), etc...
- As for claim 6: The second set of information is image information which can be displayed in terminals of a community (0111,0112, figure 16).
- As for claims 7, 20: It is implicitly included that the size of the image information (i.e., the pictures of other users) changes according to the number of members participating in the community.
- As for claim 18: A fifth set of information corresponding to an exclusive virtual space is generated for each user for exclusive use by the user, wherein the second set of information is contained in the fifth set of information, and outputting by a second output controller the fifth set of information to the users in the network (0099-0105, 0112, figures 11, 16).
- As for claim 19: The second set of information includes image information regarding the community and is displayable on other terminals within the exclusive virtual space output by the second output controller (figs 11, 16).

***Claim Rejections - 35 USC § 103***

2. Claims 3, 4, 8, 14-17, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent application publication #2003/0093474 (Kakuta et al).

- As for claim 3: The first user has the authority to designate the second user to be a member of the community (0012, 0067). Kakuta et al fail to clearly teach that the first user is a controller of the community. However implementation of a group controller is

well known virtual conferencing or chat. It would have been obvious to one of skill in the art, at the time the invention was made, to implement the group controller to Kakuta's teaching of group membership. Motivation of the combining is for controlling the membership in the group.

- As for claims 4, 17: Membership can be canceled or added by canceling and issuing of group card (0067). Kakuta et al fail to clearly teach that membership can be reassigned. However, it would have been obvious to one of skill in the art, at the time the invention was made, to implement the reassigning the membership to a second user. The implementation would have been obvious in light of Kakuta's teaching of designating a new member and real life social activities.
- As for claims 8, 14, 21: The first user has the authority to designate the second user to be a member of the community (0012, 0067). Kakuta et al fail to clearly teach that the first user is a controller (owner) of the community. However implementation of a group controller is well known virtual conferencing or chat. It would have been obvious to one of skill in the art, at the time the invention was made, to implement the group controller to Kakuta's teaching of group membership. Motivation of the combining is for controlling the membership in the group. Implementation of displaying the owner's community distinguishable from the others would have been obvious for visual identification.
- As for claim 15: Kakuta et al fail to clearly teach the dragging of the third set of information to the second user. However implementation of drag/drop is well known in computer GUI. It would have been obvious to one of skill in the art, at the time the

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invention was made, to implement the dragging of the third set of information to the second user. Motivation of the implementation is for the advantage of visually controlling the sending of the third set of information.

- As for claim 16: Users are represented as avatars (figure 16).

### ***Response to Arguments***

3. Applicant's arguments have been considered but are deemed persuasive.

#### **REMARKS:**

In response to the argument that Kakuta does not teach exchanging information between users relates to entering or joining a new virtual community as in claim 1, this limitation of exchanging information between users relates to entering or joining a new virtual community is not recited in the language of claim 1.

In response to the argument that Kakuta does not teach the drag and drop an icon representing a virtual community onto a second user, this limitation is also not recited in claim 1.

In response to the argument that Kakuta does not teach the second generation means for generating a second set of information including an information list showing said community a first user participates in from information relating to said plurality of user, the limitation is disclosed by Kakuta in 0067 and figure 16. The applicant further argues that Kakuta's information on the generated group card relates to personal information, not information related to a *community or group* that each user participates in. The argument is not supported by the language of claim 1, i.e., "information relating to *the plurality of users*".

In response to the argument that Kakuta does not teach a display that display a portion of the virtual space and the information list, the limitation is disclosed in figure 11, 13 and 16, wherein the chat room is a virtual communication space, and wherein the list of participants (Takako, Kei, Kenichi) is also displayed. The applicant acknowledged that Kakuta teaches a chat room, however argues that Kakuta's chat room is two-dimensional, not a virtual space or three-dimensional as claimed. The applicant appears to argue that virtual space is three-dimensional space. This argument is not deemed persuasive since a display virtual space does not have to be three-dimensional. Furthermore, Kakuta teaches the implementation of chat room in virtual world (0008). By definition, a "virtual world" is a three dimensional modeled environment (Microsoft Press Computer Dictionary).

In response to the argument regarding input from other terminal of a fourth set of information, the fourth set of information input by other terminals is disclosed by Kakuta in 0067-0070 and 0099. The transferring of icon is not recited in claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,956,038 discloses virtual reality space. See the abstract.

US 6,559,863 discloses electronic conferencing in virtual space and the drag/drop of avatars (see figures 2-4).



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US 5,796,395 discloses matching and grouping of users with common interests. See the abstract.

US 5,999,208 discloses electronic meeting in virtual space. See the abstract.

US 6,772,195 discloses chat clusters in a virtual world. See the abstract.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Huynh whose telephone number is (571) 272-4138. The examiner can normally be reached on Mon - Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Primary Examiner  
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6/3/05

  
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